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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,865	09/10/2003	Rex W. Halverson	2910-002	5087

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EXAMINER
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NEGRON, ISMAEL

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/659,865

Applicant(s)

HALVERSON ET AL.

Examiner

Ismael Negron

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-218 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-18 is/are allowed.
- 6) ☐ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed on June 10, 2005 has been entered. Claims 1, 8, 10, 11 and 17 have been amended. Claims 3, 19 and 20 have been cancelled. No claim has been added. Claims 1, 2 and 4-18 are still pending in this application, with claims 1 and 11 being independent.
2. The indicated allowability of claims 3 and 10 is **withdrawn** in view of the newly discovered references. Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by WARMAN (U.S. Des. Pat. No. 63,528).
4. WARMAN discloses a chandelier having:
  - **a frame (as recited in Claim 1), as seen in Figure 1;**
  - **a plurality of hangers (as recited in Claim 1), as seen in Figure 1;**

- **a plurality of means for providing decorative illumination (as recited in Claim 1), as seen in Figure 1;**
- **the plurality of means for providing decorative illumination being mounted on the frame (as recited in Claim 1), as seen in Figure 1;**
- **the frame being configured in the form of a ring (as recited in Claim 2), as seen in Figure 2;**
- **a plurality of holders (as recited in Claim 4), as seen in Figure 1;**
- **the holders being connected to the frame (as recited in Claim 4), as seen in Figure 1;**
- **each holder removably receiving one of the decorative illumination means (as recited in Claim 4), as seen in Figure 1;**
- **the decorative illumination means being an incandescent lamp (as recited in Claim 7), as seen in Figure 1;**
- **the decorative illumination means and the holders being interspersed around the frame (as recited in Claim 8), as seen in Figure 1;**
- **the frame forming at least one metal ring (as recited in Claim 9), as seen in Figure 1; and**

- artistic elements being attached to the frame (as recited in Claim 9), as seen in Figure 1.

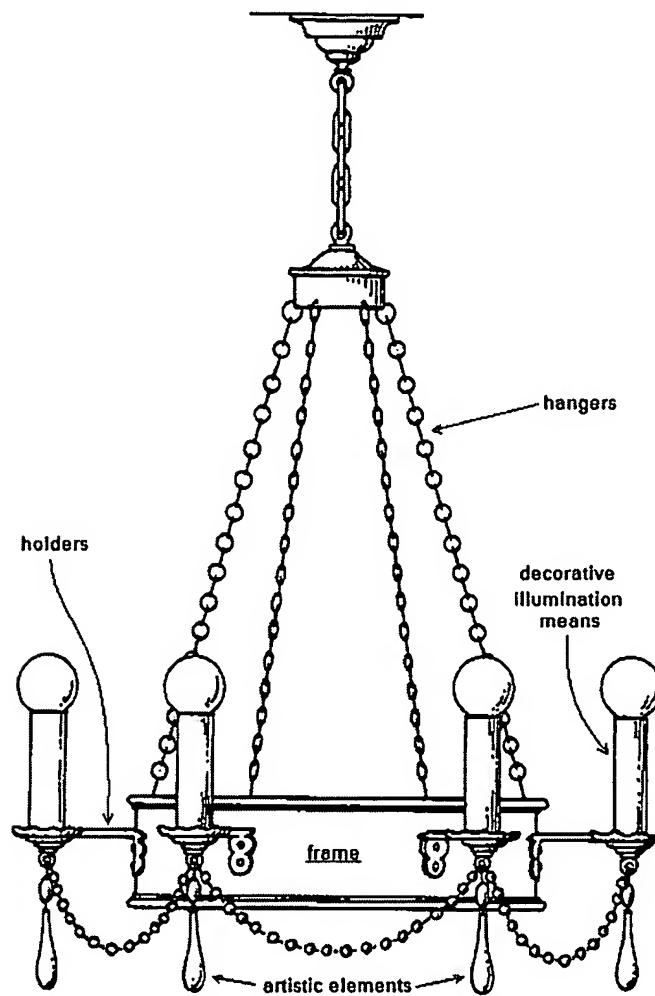


FIG. 1 of WARMAN (U.S. Des. Pat. No. 63,528) modified to identify elements corresponding to the structural elements of the claimed invention.

5. Claim 1 also recite the following functional limitations:
- the frame being configured to surround the post;
  - the hangers being for each connecting the frame to a corresponding one of the struts;

- the hangers uniformly suspending the frame beneath the canopy;
- the hanger suspending the frame at a plurality of circumferentially spaced locations; and
- the hanger suspending the frame at a predetermined safe distance above a horizontal table surface through which the post extends.

6. Regarding the intended use recitations presented in the preamble of Claim 1 (e.g. *"for mounting on a patio table umbrella having a canopy supported by a plurality of ribs that extend radially from the upper end of a vertical post and a plurality of radially extending struts connected to the ribs"*), the applicant is advised that such recitations where considered having no patentable weight as the body of the claim fully and intrinsically sets forth all of the structural limitations of the claimed invention. The preamble of Claim 1, as stated in the previous Office Action, merely states the purpose or intended use of the invention, rather than providing any distinct definition of any of the claimed invention's limitations over the Prior Art. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 51 USPQ2d 1161 (Fed. Cir. 1999). See also *Rowe v. Dror*, 42 USPQ2d 1550 (Fed. Cir. 1997).

7. Regarding the functional limitations, the applicant is advised that it has been held by the courts that the recitation that an element is adapted to (e.g. *"suitable for"*, *"configured to"*) perform a function, or serve in a given application, is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In

this case the patented frame of WARMAN was considered capable of performing, or being used, as claimed.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 6 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WARMAN (U.S. Des. Pat. No. 63,528).
9. WARMAN discloses a chandelier suitable for mounting on a patio table umbrella having a canopy supported by a plurality of ribs that extend radially from the upper end of a vertical post and a plurality of radially extending struts connected to the ribs, the chandelier having:
  - **a frame (as recited in Claim 1), as seen in Figure 1;**
  - **a plurality of hangers (as recited in Claim 1), as seen in Figure 1;**
  - **a plurality of means for providing decorative illumination (as recited in Claim 1), as seen in Figure 1;**and

- **the plurality of means for providing decorative illumination being mounted on the frame (as recited in Claim 1), as seen in Figure 1.**

10. WARMAN discloses all the limitations of the claims, except:

- the decorative illumination means being a candle (as recited in Claim 5);
- the decorative illumination means being an oil lamp (as recited in Claim 6); and
- each hanger having double ended hooks (as recited in Claim 10).

11. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use a candle (as recited in Claim 5), or an oil lamp (as recited in Claim 6) as the decorative illumination means of WARMAN, to be able to provide illumination for a patio umbrella even when an electrical power source was not available. In addition, the Examiner takes Official Notice of applicant's statements regarding specific types of light sources being devoid of any criticality to the subject matter of the invention, with incandescent lamps being one of many different light sources usable in the claimed chandelier (see paragraph 19, lines 2-6).

12. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to use hangers having double ended hooks (as recited in Claim 10) as the hangers of WARMAN, since the Examiner takes Official Notice that



such double ended hooks are old and well known in the art. One would have being motivated to substitute the hangers of WARMAN for double ended hooks to be able to easily connect and disconnect the patented frame for its supporting structure.

In addition, the Examiner further takes Official Notice of applicant's statements regarding specific type of hanger structures being devoid of any criticality to the subject mater of the invention, with double ended hooks being one of many different hangers usable in the claimed chandelier (see paragraph 19, lines 6-11). It is also noted that the applicant specifically mentions the hanger structure of WARMAN (e.g. "links") as an equivalent to the claimed double ended hooks (see paragraph 19, line 8).

***Allowable Subject Matter***

13. Claims 11-18 are allowed.

14. The following is a statement of reasons for the indication of allowable subject matter:

Applicant teaches a combination collapsible umbrella, chandelier and patio table having a frame surrounding a vertical post of the patio table umbrella, such frame including a plurality of means for providing decorative illumination. The frame is connected to the umbrella struts by double-ended hooks positioned at plurality of circumferentially spaced locations, for uniformly suspending the frame from the struts under the canopy of the umbrella at a safe distance above the horizontal surface of the patio table.

While collapsible umbrellas, chandeliers and patio tables are old and well known in the art, no prior art was found teaching individually, or suggesting in combination, all of the features of the applicants' invention, specifically the collapsible umbrella and patio table in combination with the particular structure of the claimed chandelier.

***Relevant Prior Art***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Phyle** (U.S. Pat. 5,584,564), **Li** (U.S. Pat. App. Pub. 2004/0226598) and **Ma** (U.S. Pat. App. Pub. 2005/0117326) disclose a plurality of illumination devices for use with patio table umbrellas.

**Barret** (U.S. Pat. 1,349,312), **D'Olier, Jr.** (U.S. Pat. 1,883,620), **Goodwin** (U.S. Pat. 3,828,181), **Lacinski** (U.S. Pat. 4,305,120), **Sokol** (U.S. Pat. 3,321,660) and **Van Ess** (U.S. Pat. 4,335,422) disclose a plurality illumination devices having hooks for attaching such devices to supporting structures.

**Crumley** (U.S. Des. Pat. 70,540), **Friedman** (U.S. Des. Pat. 71,966), **Ganger** (U.S. Des. Pat. 134,482), **Schonbek** (Int. App. Pub. No. WO 91/19934), **Glassman** (U.S. Des. Pat. 330,948) and **Lupien** (U.S. Des. Pat. 369,878) disclose a plurality of chandeliers supported by hanging means having double-ended hooks.

***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER  
PRIMARY EXAMINER

Inr

August 20, 2005